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BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, VA 22314-1176

EXAMINER

LAZARO, DAVID R

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/732,791		YU ET AL.	
	Examiner		Art Unit	
	David Lazaro		2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 20-33, 35, 40-49, 52-60, 69-71, 73-76 and 78-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 20-33, 35, 40-49, 52-60, 69-71, 73-76, 78-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed 09/28/2005.
2. Claims 1, 20, 52 and 71 were amended.
3. Claims 18, 19, 34, 36-39, 50, 51, 61, 62, 64, 65, 67, 68 and 72 are canceled.
4. Claims 1-7, 20-33, 35, 40-49, 52-60, 69-71, 73-76, 78-83 are pending in this office action.

Response to Amendment

5. Applicant's arguments filed 09/28/05 have been fully considered but they are not persuasive. See 'Response to Arguments'. As such, the previous grounds of rejection are maintained as presented in the office action mailed 06/28/05, with adjustments made in light of the amendments.
6. The objections to Claims 1 and 20 are withdrawn.
7. The rejection of claim 20 under 35 U.S.C. 112, first paragraph, is maintained as all the issues were not addressed by applicants' amendment.
8. The rejection of claim 52 under 35 U.S.C. 112, first paragraph, is withdrawn.
9. The examiner also notes that claim 40 was given an incorrect status identifier ("currently amended" vs. "previously presented": no amendments were indicated). Please check all status identifiers in future amendments to avoid possible delays in prosecution.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 20 includes the following limitations:

“transforming said transmission signal into an identification information if said transmission signal corresponds with predetermined deletion conditions”

(emphasis added). The emphasized subject matter above is not described in the specification. Descriptions of the “filtering” element/embodiments are given on pages 7, 8, 11, 12 of the specification. However, the descriptions on these pages do not describe determinations of if a transmission signal corresponds with predetermined deletion conditions. These pages at best, describe filtering of identification information or the electronic mail, but not filtering of transmission signals nor transmission signals corresponding with predetermined deletion conditions. Because of this, Claim 20 fails to comply with the written description requirement. The examiner suggests changing the emphasized language to either “if said identification information” or “if said new electronic mail”.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 2, 5-12, 15, 16, 20-27, 30, 31, 33, 35, 40-47, 52-58, 63, 66 and 70 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,212,265 by Duphorne (Duphorne).

14. With respect to Claim 1, Duphorne teaches a method for actively providing users with the message concerning new mail, carried out by an electronic mail provider (Col. 2 lines 18-22 and Col. 3 line 60 - Col. 4 line 31), said method comprising:

creating identification information of said new mail upon detecting said new mail by an electronic mail provider (Col. 2 lines 21-35 and Col. 3 line 60 - Col. 4 line 31);

filtering said identification information by a filtering device for stopping transforming said identification information into said transmission signal if said new mail corresponds with a plurality of set deletion conditions (Col. 4 lines 32-47 and Col. 5 lines 1-7);

transforming said identification information into a transmission signal (Col. 2 lines 21-35) if said identification information corresponds with predetermined deletion conditions (Col. 4 lines 32-47 and Col. 5 lines 1-7); and

transferring said transmission signal in conjunction with a first signal and a second signal to a non-portable receiving terminal (Col. 2 lines 21-35 and Col. 6 line 55 - Col. 7 line 11).

transforming said transmission signal back into said identification information (Col. 8 lines 8-41).

15. With respect to Claim 2, Duphorne teaches all the limitations of Claim 1 and further teaches a step of automatically sending said identification information of said new mail to said non-portable receiving terminal after receiving a response from said non-portable receiving terminal (Col. 6 line 55 – Col. 7 line 11).

16. With respect to Claim 5, Duphorne teaches all the limitations of Claim 1 and further teaches a step of receiving said new mail by said users from said electronic mail provider through a telecommunication network after said users receiving said identification information (Col. 11 lines 2-4).

17. With respect to Claim 6, Duphorne teaches all the limitations of Claim 1 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47).

18. With respect to Claim 7, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal further comprises advertisement information of said electronic mail provider (Col. 9 lines 31-67).

19. With respect to Claim 8, Duphorne teaches all the limitations of Claim 1 and further teaches said electronic mail provider transforms said identification information

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into said transmission signal and transfers said transmission signal by using an identification communication protocol for a caller terminal (Col. 6 lines 10-54).

20. With respect to Claim 9, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a message subject for said new mail (Col. 4 lines 65-67).

21. With respect to Claim 10, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a receiving date and a receiving time (Col. 4 lines 65-67).

22. With respect to Claim 11, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises an electronic mail address of a sender (Col. 8 lines 28-33).

23. With respect to Claim 12, Duphorne teaches all the limitations of Claim 1 and further teaches said identification information comprises a name of a sender (Col. 8 lines 28-33).

24. With respect to Claim 15, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal is in a frequency shift key format (Col. 6 lines 48-50).

25. With respect to Claim 16, Duphorne teaches all the limitations of Claim 1 and further teaches said transmission signal is in a dual-tone multi-frequency format (Col. 6 lines 48-50).

26. With respect to Claim 20, Duphorne teaches a method for obtaining a message a new electronic mail (Col. 2 lines 18-22), said method comprising:

receiving a transmission signal actively transferred from an electronic mail provider through a non-portable receiving terminal (Col. 2 lines 21-35), wherein said transmission signal is transformed from an identification information filtered by a filtering device for stopping transforming said identification into said signal if said new mail corresponds with a plurality of set deletion conditions (Col. 4 lines 32-47 and Col. 5 lines 1-7); and

transforming said transmission signal into said identification information (Col. 8 lines 8-41) if said transmission signal corresponds with predetermined deletion conditions (Col. 4 lines 32-47 and Col. 5 lines 1-7), said identification information being related to said new electronic mail that is not yet received or read by users (Col. 4 lines 10-31).

27. With respect to Claim 21, Duphorne teaches all the limitations of Claim 20 and further teaches automatically transferring a response from said receiving terminal to said electronic mail provider after receiving said transmission signal, and said step of automatically transferring used for requesting said electronic mail provider to automatically transfer said identification information to said non-portable receiving terminal (Col. 6 line 55 – Col. 7 line 11).

28. With respect to Claim 22, Duphorne teaches all the limitations of Claim 20 and further teaches a step of displaying said identification information for notifying said users (Col. 8 lines 24-33).

29. With respect to Claim 23, Duphorne teaches all the limitations of Claim 20 and further teaches a step of receiving said electronic mail from said electronic mail provider

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through a telecommunication network after reading said identification information by said users (Col. 11 lines 2-4).

30. With respect to Claim 24, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a message subject for said electronic mail (Col. 8 lines 28-33).

31. With respect to Claim 25, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a receiving date and a receiving time (Col. 8 lines 28-33).

32. With respect to Claim 26, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises an electronic mail address of a sender. (Col. 8 lines 28-33).

33. With respect to Claim 27, Duphorne teaches all the limitations of Claim 20 and further teaches said identification information comprises a name of a sender (Col. 8 lines 28-33).

34. With respect to Claim 30, Duphorne teaches all the limitations of Claim 20 and further teaches said transmission signal is in a frequency shift key format (Col. 6 lines 48-50).

35. With respect to Claim 31, Duphorne teaches all the limitations of Claim 20 and further teaches said transmission signal is in a dual-tone multi-frequency format (Col. 6 lines 48-50).

36. With respect to Claim 33, Duphorne teaches all the limitations of Claim 20 and further teaches said receiving terminal comprises an electronic mail identification phone (Col. 7 lines 11-26).

37. With respect to Claim 35, Duphorne teaches all the limitations of Claim 20 and further teaches said receiving terminal comprises a caller identification phone that has electronic mail identification function (Col. 7 lines 11-26 and Col. 8 lines 37-41).

38. With respect to Claim 40, Duphorne teaches a system for actively transferring identification information of an electronic mail (Col. 2 lines 18-35), said system comprising:

modulating means for transforming said identification information into a transmission signal (Col. 6 lines 44-56); and

transferring means for transferring said transmission signal to a receiving terminal of a user (Col. 6 lines 44-56); and

a filtering device, wherein said filtering device stops transforming identification information into said transmission signal if the electronic mail corresponds with predetermined delete conditions (Col. 4 lines 32-47 and Col. 5 lines 1-7), said filtering device transforms said identification information into said transmission signal if the electronic mail corresponds with said predetermined permission conditions (Col. 4 lines 32-47 and Col. 5 lines 1-7).

39. With respect to Claim 41, Duphorne teaches all the limitations of Claim 40 and further teaches a mail server which is set in said electronic mail provider, wherein said

mail server is used for receiving and transferring said electronic mails (Col. 3 lines 60-66).

40. With respect to Claim 42, Duphorne teaches all the limitations of Claim 40 and further teaches said electronic mail provider transforms said identification information into said transmission signal and transfers said transmission signal by utilizing an communication protocol of identification service by a caller terminal (Col. 6 lines 44-56).

41. With respect to Claim 43, Duphorne teaches all the limitations of Claim 40 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47).

42. With respect to Claim 44, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a message subject for said electronic mail (Col. 4 lines 65-67).

43. With respect to Claim 45, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67).

44. With respect to Claim 46, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33).

45. With respect to Claim 47, Duphorne teaches all the limitations of Claim 40 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33).

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46. With respect to Claim 52, Duphorne teaches a system for assisting a user in acquiring a message concerning new electronic mail (Col. 2 lines 18-35), said system comprising:

non-portable receiving means for receiving a transmission signal which is transferred from an electronic mail provider (Col. 7 lines 11-20);

analyzing means for transforming said transmission signals into an identification information of said new electronic mail (Col. 8 lines 8-28);

displaying means for displaying said identification information (Col. 7 lines 48-57); and

a filtering device for stopping transforming said identification information into said transmission signal if said new electronic mail corresponds with a plurality of set deletion conditions prior to transferring said transmission signal (Col. 4 lines 32-47 and Col. 5 lines 1-7).

47. With respect to Claim 53, Duphorne teaches all the limitations of Claim 52 and further teaches a storage device for storing said identification information (Col. 8 lines 15-20).

48. With respect to Claim 54, Duphorne teaches all the limitations of Claim 52 and further teaches said electronic mail provider translates said identification information and transfers said transmission signal by utilizing an communication protocol of identification service by a caller terminal (Col. 6 lines 44-56).

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49. With respect to Claim 55, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a message subject for said new electronic mail (Col. 4 lines 65-67).

50. With respect to Claim 56, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67).

51. With respect to Claim 57, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33).

52. With respect to Claim 58, Duphorne teaches all the limitations of Claim 52 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33).

53. With respect to Claim 63, Duphorne teaches all the limitations of Claim 52 and further teaches said non-portable receiving means comprises an identification phone of a caller terminal which has electronic mail identification function (Col. 7 lines 11-26 and Col. 8 lines 37-41).

54. With respect to Claim 66, Duphorne teaches all the limitations of Claim 52 and further teaches said displaying means comprises an audio broadcasting device (Col. 7 lines 48-60).

55. With respect to Claim 70, Duphorne teaches all the limitations of Claim 52 and further teaches further teaches a connecting device for connecting said receiving

terminal and electronic mail provider when said transmission signal is received (Col. 7 lines 11-26).

Claim Rejections - 35 USC § 103

56. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

57. Claims 3, 4, 13, 14, 28, 29, 48, 49, 59, 60, 71 and 73-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent 5,933,478 by Ozaki et al. (Ozaki).

58. With respect to Claim 3, Duphorne teaches all the limitations of Claim 1 and but does not explicitly disclose suspending a connection between the mail provider and non-portable receiving terminal. Ozaki teaches a similar method of providing to a user a message concerning a new electronic mail (Col. 10 line 58 - Col. 11 line 12). Ozaki teaches that a connection between electronic mail provider and the receiving terminal is suspended by detecting a first deadline of establishing said connection (Col. 12 lines 40-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the method further comprises a step of suspending a connection between said electronic mail provider and said non-portable receiving

terminal. One would be motivated to have this as it insures a user will receive notification of important newly received information (Col. 2 lines 4-28 of Ozaki).

59. With respect to Claim 4, Duphorne in view of Ozaki teaches all the limitations of Claim 3 and further teaches a step of re-establishing said connection and thereafter transferring said transmission signal (Col. 12 lines 40-56 of Ozaki).

60. With respect to Claim 13, Duphorne teaches all the limitations of Claim 1 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

61. With respect to Claim 14, Duphorne in view of Ozaki teaches all the limitations of Claim 13 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

62. With respect to Claim 28, Duphorne teaches all the limitations of Claim 20 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code.

One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

63. With respect to Claim 29, Duphorne in view of Ozaki teaches all the limitations of Claim 28 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

64. With respect to Claim 48, Duphorne teaches all the limitations of Claim 40 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code. One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

65. With respect to Claim 49, Duphorne in view of Ozaki teaches all the limitations of Claim 48 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

66. With respect to Claim 59, Duphorne teaches all the limitations of Claim 52 but does not explicitly disclose identification information comprising a distinctive code. Ozaki teaches identification information comprising a distinctive code (Col. 9 lines 23-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as indicated by Ozaki such that the identification information comprises a distinctive code.

One would be motivated to have this as it helps give a user immediate access to newly received information (Col. 2 lines 15-19 and 40-44 of Ozaki).

67. With respect to Claim 60, Duphorne in view of Ozaki teaches all the limitations of Claim 59 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

68. With respect to Claim 71, Duphorne teaches a method for transferring an identification information of an electronic mail (Col. 2 lines 18-35), said method comprising:

- receiving a new electronic mail (Col. 2 lines 21-35 and Col. 3 line 60 - Col. 4 line 31);

- transferring a transmission signal from an electronic mail provider to a receiving terminal which is predetermined by a corresponding user of said electronic mail (Col. 4 lines 20-31);

- transferring an identification information of said electronic mail to said receiving terminal when a response message from said receiving terminal is received within a predetermined period (Col. 4 lines 20-31).

Duphorne does not explicitly disclose suspending a connection if no response is received after a predetermined period and re-establishing said connection between said electronic mail provider and said receiving terminal after suspending said connection and thereafter waiting a standby period. Ozaki teaches that a connection between electronic mail provider and the receiving terminal is suspended when no response is received after a predetermined period (Col. 12 lines 40-56). Ozaki further teaches

reestablishing said connection between said electronic mail provider and said receiving terminal after suspending said connection and thereafter waiting a standby period (Col. 12 lines 40-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that the method further comprises suspending a connection between said electronic mail provider and said receiving terminal when no said response message is received within said predetermined period; and re-establishing said connection between said electronic mail provider and said receiving terminal after suspending said connection and thereafter waiting a standby period. One would be motivated to have this as it insures a user will receive notification of important newly received information (Col. 2 lines 4-28 of Ozaki).

69. With respect to Claim 73, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches a step of connecting to said electronic mail provider for getting said electronic mail after receiving said identification information (Col. 7 lines 27-29 of Duphorne).

70. With respect to Claim 74, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches a step of storing said identification information on said receiving terminal for displaying when said user queries (Col. 8 lines 8-28 of Duphorne).

71. With respect to Claim 75, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said electronic mail provider transfers said transmission signal during a specific period (Col. 4 lines 40-47 of Duphorne).

72. With respect to Claim 76, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a message subject for said electronic mail (Col. 4 lines 65-67 of Duphorne).

73. With respect to Claim 77, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a date and a time (Col. 4 lines 65-67 of Duphorne).

74. With respect to Claim 78, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a sender's electronic mail address (Col. 8 lines 28-33 of Duphorne).

75. With respect to Claim 79, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a sender's name (Col. 8 lines 28-33 of Duphorne).

76. With respect to Claim 80, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said identification information comprises a distinctive code (Col. 9 lines 23-30 of Ozaki).

77. With respect to Claim 81, Duphorne in view of Ozaki teaches all the limitations of Claim 80 and further teaches said distinctive code comprises a telephone number of said electronic mail provider (Col. 9 lines 23-30 of Ozaki).

78. With respect to Claim 82, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches hardware of said receiving terminal has a caller identification function (Col. 8 line 38-41 of Duphorne).

79. With respect to Claim 83, Duphorne in view of Ozaki teaches all the limitations of Claim 71 and further teaches said receiving terminal further comprises a connecting device for establishing a connection between said receiving terminal and said electronic mail provider (Col. 7 lines 11-26).

80. Claims 17 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent 5,875,234 by Clayton et al. (Clayton).

81. With respect to Claim 17, Duphorne teaches all the limitations of Claim 1. Although Duphorne teaches the transmission format is of an appropriate format for the email notification device according to Caller ID protocols (Col. 6 lines 44-47), Duphorne does not explicitly disclose the transmission signal is in a universal asynchronous receive and transmission (UART) format. Clayton teaches that the UART format is typically used for Caller ID services (Col. 9 lines 52-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that said transmission signal is in a UART format. One would be motivated to have this as it can be easily integrated with existing protocols and infrastructure (Col. 2 lines 22-34 of Duphorne).

82. With respect to Claim 32, Duphorne teaches all the limitations of Claim 20. Although Duphorne teaches the transmission format is of an appropriate format for the email notification device according to Caller ID protocols (Col. 6 lines 44-47), Duphorne does not explicitly disclose the transmission signal is in a universal asynchronous

receive and transmission (UART) format. Clayton teaches that the UART format is typically used for Caller ID services (Col. 9 lines 52-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Duphorne and modify it as indicated by Ozaki such that said transmission signal is in a UART format. One would be motivated to have this as it can be easily integrated with existing protocols and infrastructure (Col. 2 lines 22-34 of Duphorne).

83. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duphorne in view of U.S. Patent Application Publication 2001/0012286 by Huna et al. (Huna).

84. With respect to Claim 69, Duphorne teaches all the limitations of Claim 20 but does not explicitly disclose a switch device for controlling operation of the non-portable receiving means. Huna teaches a switch device for controlling the receiving means such that transmission signals concerning new email are received when it is on and not received when it is off (Page 6 [0071]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the system disclosed by Duphorne and modify it as indicated by Huna such that there is a switch device for controlling operation of said non-portable receiving means, said non-portable receiving means receiving said transmission signal when said switch device is on, and said receiving terminal stopping receiving said transmission signal when said switch device is off. One would be

motivated to have this as it is desirable to allow the user to configure the notification system according to their current preference (Page 6 [0071]).

Response to Arguments

85. Applicants' arguments filed 09/28/05 have been fully considered but they are not persuasive.

86. Applicants argue on pages 14-15 of the remarks - *"The method of Duphorne provides a user with a Caller ID-compatible email notification signal indicating that email addressed to the user is received at a remote email server associated with the user. The method comprises a step of transmitting a query signal to the remote email server, a step of transmitting, in response to the query signal, a preliminary email notification signal from the remote email..."*

a. Examiner's response - The examiner respectfully disagrees with applicants' interpretation of Duphorne. As stated repeatedly in the "Response to arguments" section of the previous office actions (mailed 9/7/04 and 06/28/05), the system of Duphorne does not necessarily query the user's ISP email server. The system includes automatic notification by the email server to the central office upon the arrival of a new email (Col. 4 lines 10-14). Furthermore, the central office may itself contain and maintain the users email server as described in Col. 3 lines 27-34, and Col. 3 line 66- Col. 4 line 20.

87. Applicants argue on page 15 of the remarks - *"The method of Duphorne does not include the steps of filtering the identification information by a filtering device for stopping transforming the identification information into the transmission signal if the new mail corresponds with a plurality of set deletion conditions."*

b. Examiner's response - As described in the previous office action (see *Response to Arguments* of the action mailed 06/28/05), Duphorne does teach a step of filtering through the use of a user notification parameter database (Col. 4 lines 32-47). The database is used for "spam filtering information, and/or other filtering information such as, for instance, particular usernames and/or domain names from which the user does not wish to receive email notification" (Col. 4 lines 40-47). Col. 5, lines 1-7 further describes examples of filtering based on email sources, email subject or content, as well as filtering based on any additional information as desired. Such filtering information can either permit or deny the transmission of the notification to the receiving terminal (Col. 4 lines 40-47 and Col. 5 lines 1-7). The examiner considers this to be within the scope of the claimed subject matter.

88. Applicants argue on page 15 of the remarks - "*The method of Duphorne does not include the steps of... transferring the transmission signal in conjunction with a first signal and a second signal to a non-portable receiving terminal*"

c. Examiner's response - The rejection now includes the citation from Duphorne of Col. 6, line 55, through Col. 7, line 11, which teaches this limitation introduced by the amendment.

89. Applicants argue on page 15 of the remarks - "*The method of Duphorne does not include the steps of...transforming the transmission signal back into the identification information.*"

d. Examiner's response - The rejection now includes the citation from Duphorne of Col. 8, lines 8-41, which teaches this limitation introduced by the amendment.

90. Applicants argue on page 15 of the remarks - "*Moreover, Duphorne does not show the step of receiving a transmission signal actively transferred from an electronic mail provider through a non-portable receiving terminal, wherein the transmission signal is transformed from an identification information filtered by a filtering device for stopping transforming the identification information into the transmission signal if the new mail corresponds with a plurality of set deletion conditions. Instead, the system of Duphorne queries the user's ISP email server to determine whether any email addressed to the user is received by and/or stored thereon. The ISP email server 16a receives a query signal from a query software maintained by a central office 14 first or an information service provider so as to transmit a preliminary email notification signal in respond to the query signal.*"

e. Examiner's response - As stated above, the system of Duphorne does not necessarily query the user's ISP email server. The system includes automatic notification by the email server to the central office upon the arrival of a new email (Col. 4 lines 10-14). Furthermore, the central office may itself contain and maintain the users email server as described in Col. 3 lines 27-34, and Col. 3 line 66- Col. 4 line 20.

f. Also as described above, Duphorne teaches filtering through the use of a user notification parameter database (Col. 4 lines 32-47). The database is used for "spam filtering information, and/or other filtering information such as, for instance, particular usernames and/or domain names from which the user does not wish to receive email notification" (Col. 4 lines 40-47). Col. 5, lines 1-7 further describes examples of filtering based on email sources, email subject or content, as well as filtering based on any additional information as desired. Such filtering information can either permit or deny the transmission of the notification to the receiving terminal (Col. 4 lines 40-47 and Col. 5 lines 1-7). The examiner considers this to be within the scope of the claimed subject matter.

g. For these reasons, applicants' arguments are not persuasive.

91. Applicants argue on pages 15-16 of the remarks - *"In addition, the Duphorne patent fails to teach a filtering device for suspending preliminary email notification signal in response to a plurality of set deletion conditions prior to formatting the preliminary email notification signal into the Caller ID-compatible email notification signal. In contrast, the system of the claimed invention comprises a filtering device that stops transforming the identification information into the transmission signal if the electronic mail corresponds with some predetermined delete conditions, or transforms the identification information into the transmission signal if the electronic mail corresponds with some predetermined permission conditions."*

h. Examiner's response - As described above, Duphorne teaches filtering through the use of a user notification parameter database (Col. 4 lines 32-47). The database is used for "spam filtering information, and/or other filtering information such as, for instance, particular usernames and/or domain names

from which the user does not wish to receive email notification" (Col. 4 lines 40-47). Col. 5, lines 1-7 further describes examples of filtering based on email sources, email subject or content, as well as filtering based on any additional information as desired. Such filtering information can either permit or deny the transmission of the notification to the receiving terminal (Col. 4 lines 40-47 and Col. 5 lines 1-7). The examiner considers this to be within the scope of the claimed subject matter.

i. For these reasons, applicants' arguments are not persuasive.

92. The remaining arguments have been addressed based on the Examiner's responses above.

Conclusion

93. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lazaro whose telephone number is 571-272-3986. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Lazaro
November 17, 2005



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER